

Serial No. 09/628,501
Amdt. Dated October 12, 2004
Reply to Office Action of June 9, 2004

Docket No. LT-0001

REMARKS/ARGUMENTS

Claims 1-14, 19 and 20 are pending in the application. By the Amendment, claims 1, 4-10, 13, and 14 are amended, claims 15-18 are cancelled without prejudice or disclaimer, and claims 19 and 20 are added. It is believed that no new matter is introduced into the application. Support for the claims can be found throughout the original specification, including the original claims, and drawings, for example, at page 7, line 17 – page 8, line 2, and Figure 3. Reconsideration in view of the foregoing amendments and the following remarks is respectfully requested.

The Office Action, at page 2, objects to the Abstract as exceeding the word limit. Applicant respectfully traverses the objection and submits that grounds for the objection are obviated by the above amendment to the Abstract. Withdrawal of the objection is thus respectfully requested.

The Office Action, also at page 2, rejects claims 5 and 13 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicant respectfully traverses the rejection and submits that grounds for the rejection are obviated by the above amendments to the claims. Withdrawal of the rejection is thus respectfully requested.

The Office Action, at page 3, rejects claims 1-6, 8-13, and 15-18 under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2003/0194200 A1 to Yuen et al. (hereinafter “Yuen”) in view of U.S. Patent Publication No. 2002/081767 A1 to Ito et al. (hereinafter “Ito”). The Office Action, at page 10, rejects claims 7 and 14 under 35 U.S.C. § 103(a) over Yuen in view of Ito,

and further in view of U.S. Patent No. 6,301,588 to Aoki. Because the references, individually or in combination, fail to disclose or suggest all the features of the claims, the rejections are respectfully traversed.

Yuen relates to a method of operating a video cassette reader/recorder (VCR) by decoding the scheduling and descriptive program information from received broadcast television (TV) signals and using the decoded information in creating a program directory and controlling the VCR. Yuen further appears to relate to a method of encoding the magnetic tape with control and program directory information. See, e.g., Abstract and paragraphs 21, 36, 168-170 and 173 of Yuen.

As shown in Figure 1, Yuen discloses an indexing VCR system 10 that includes a VCR 1 having a vertical blanking intervals (VBI) encoder 60b and a VBI decoder 60a. In the record mode of the VCR 1, a broadcast TV signal is input into the VBI decoder 60a from either an antenna 63 or a cable TV source 64. In a playback mode of the VCR 1, a reproduced signal from the tape 42 is input into the VBI decoder 60a through a video logic circuit 7. Connected to the VCR 1 is a directory controller 30 that includes a microprocessor controller 31 which controls the sequence and operation of the directory controller 30 and interfaces with the VCR 1 to implement the necessary functional capabilities for reading, updating, and recording the directory. (Paragraphs 203, 224, and 419). Accordingly, Yuen discloses a method for recording a broadcast TV signal on an analog tape and playback capabilities of the tape according to a directory controller.

Ito relates to a data communication apparatus for encoding information data, in which a PC and a digital VTR are connected using an IEEE 1394 interface. The IEEE 1394 packet includes management data such as a bus ID number. See, Abstract, paragraphs 78 and 93, and Figures 3 and 5 of Ito.

Whereas, amended claim 1 is directed to a method for storing digital data from a storage device to a digital recording medium, that includes features of searching for a recordable location in the digital recording medium when a data store is requested from the storage device in communication with the digital recording medium through a digital interface, wherein the storage device includes a microprocessor and a memory. Claim 1 further recites features of recording data streams received through the digital interface from said memory of said storage device in the location discovered from the searching, wherein the data streams have been converted from the data of a multimedia file which is selected in the storage device. Claim 1 further recites the features of creating management information regarding the data streams recorded. By way of a non-limiting example, Figure 2 of the present application shows a system including a DVHS-TVCR connected to a PC, in which the DVHS-TVCR is configured to read data streams through a digital interface (e.g., 42 and 51) from a memory (e.g., 53) of the PC, and store the read data streams in a digital recording medium (e.g., 31) used in the DVHS-TVCR.

Amended independent claim 8 is directed to a method for retrieving digital data from a digital recording medium and sending the reproduced data to a storage device through a digital interface. Claim 8 recites reproducing management information recorded in the digital recording

medium when a retrieving request for a given multimedia file is received from a microprocessor of said storage device; identifying a recording location of the given multimedia file based upon the reproduced management information; searching for the identified location in the digital recording medium and reproducing recorded data from the identified location; converting the reproduced data into transport streams (TS) and transmitting the TS data to the microprocessor of said storage device; and storing the transmitted TS data in a memory of said storage device. By way of a non-limiting example, the previously described system of Figure 2 shows a PC configured to read data streams through a digital interface (e.g., 42 and 51) from a digital recording medium (e.g., 31) used in the DVHS-TVCR, and store the read data streams in a memory (e.g., 53) of the PC.

Applicant submits that the deficiencies set forth above with respect to the combination of Yuen and Ito are not cured by the further combination of Aoki, as Aoki also fails to disclose or suggest at least features of searching for a recordable location in the digital recording medium when a data store is requested from the storage device in communication with the digital recording medium through the digital interface. Accordingly, not even the combination of the references discloses or suggests all the features or their combination of the claims.

Further, the Office Action, at page 3, acknowledges that Yuen fails to disclose the digital recording medium, the digital interface, and creating management information regarding the data streams recorded. Nevertheless, the Office Action indicates Ito discloses a data communication apparatus, method, system, and programs for data communication process stored in a computer

readable storage medium in which an apparatus such as a PC or a digital VTR is interconnected by an IEEE 1394 interface. The Office Action further indicates the IEEE 1394 packet includes management data such as bus ID number, apparatus ID, packet type specific information, and the like. The Office Action then concludes that it would have been obvious to incorporate the digital video tape recorder of Ito into the Yuen video control system to increase the quality of video to be recorded and reproduced. For at least the following reasons, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness for claim 1 based upon the suggested combination.

As stated in MPEP § 2143.01, if a proposed modification or combination of references changes the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Applicant respectfully submits that combining the references in the manner suggested in the Office Action would change the principle operation of the video tape indexing method of Yuen, as well as the data communication apparatus and method of Ito. Applicant respectfully submits Yuen relates to the control of video recording equipment for locating a tape location for recording an input broadcast TV signal and indexing the tape with the recorded program information. In contrast, Applicant respectfully submits the principle operation of Ito relates to data communication among digital devices including a PC and a digital VTR through a 1394 serial bus. Accordingly, substituting a signal from a device disclosed in Ito

for the broadcast TV signal to be input into the video control system of Yuen would change its principle operation, and therefore motivation or suggestion to modify is lacking.

Further, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, where some teaching, suggestion, or motivation to do so is found therein the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified, which Applicant submits they can not, does not render a resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F. 2d 680 16 USPQ2d 1430 (Fed. Cir. 1990). Because the Office Action fails to assert that either reference contains such motivation, a *prima facie* case of obviousness has not been made. In contrast, Applicant respectfully submits that the Office Action uses improper hindsight for the suggested combination.

For at least the above reasons, Applicant respectfully submits that independent claims 1 and 8 are allowable. Claims 2-7 and 9-14 depend from claims 1 and 8, respectively, and thus are allowable for at least the same reasons, as well as additional patentable features recited therein and the combinations thereof. Withdrawal of the rejections is thus respectfully requested. Claims 15-18 are cancelled and the rejection thereof is therefore moot.

Serial No. 09/628,501

Docket No. LT-0001

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Applicant respectfully submits that new claims 19 and 20 ultimately depend from claim 1 and are thus allowable for at least the same reasons. Accordingly, favorable consideration and prompt allowance are earnestly solicited

Serial No. 09/628,501
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Docket No. LT-0001

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Garth D. Richmond**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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